

Applicants traverse this requirement. Reconsideration and withdrawal thereof are earnestly requested.

Applicants submit that there is not an undue burden placed upon the Examiner to search and consider all of the claims.

The Examiner is respectfully requested to consider the fact that the present application is directed to ablating RNA and protein expression and enabling modulation of gene expression by specific binding of antisense nucleic acids to target RNA. Thus, the application is directed to inhibiting expression of selected proteins as indicated in the Group II claims or to screen for gene function by assaying for a variety of phenotypes caused after binding between the antisense molecule and the target RNA as described in Group IV claims. Since both Group II and Group IV require the use of the same agent or large circular nucleic acid containing target specific antisense region as described in Group I claims, the agent used and the method of its use are closely related and inseparable. Therefore, all of the claims in Groups I, II, and IV should be considered and examined as a single invention.

The large circular nucleic acid molecule encompassing target-specific antisense nucleic acid, which is described in Group I claims, may be generated using the method indicated and claimed in the Group III claim. Therefore, the Group I claims and the claim in Group III are related by a special technical feature, and thus, Group III claim describing the method of making the large circular nucleic acid molecule should be considered and examined together with the Group I claims drawn to the nucleic acid product.

Further, it would not require undue experimentation for the Examiner to examine altogether the claims drawn to large circular nucleic acid molecule comprising target-specific antisense region(s), as well as methods of making the molecule and methods of using them. Rather, Applicants submit that it is burdensome upon Applicants to be forced to file separate patent applications based on related claims, where the core of the discovery relates to using a large circular nucleic acid molecule comprising a target-specific antisense region to reduce the expression of gene(s). Accordingly, all of the claims should be joined and examined together.

However, in order to be responsive to the outstanding Restriction Requirement, Applicants provisionally elect to prosecute Group I, claims 1-11, 22, and 23, drawn to a large

circular nucleic acid containing target specific antisense region, for prosecution on the merits, with traverse. Applicants specifically preserve the right to prosecute the non-elected claims.

At the least, the restriction requirement separating out the method of use claims should be held in abeyance until allowable subject matter is found in the product claims, and then rejoined and considered at that time, as provided for under *In re Ochiai* and *In re Brouwer*.

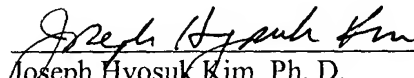
Accordingly, early examination on the merits is respectfully requested.

The Commissioner is authorized to charge Deposit Account 502486 for any fees due to secure entry of this amendment to the extent necessary.

March 26, 2003

Respectfully submitted,

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